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Robert E Bushnell and Law Firm
1522 K Street NW
Suite 300
Washington, DC 20005-1202

EXAMINER	
MYERS, PAUL R	
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`UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEUNG-CHEOL HONG and KI-YOUNG JANG

Appeal 2007-1953
Application 09/942,961
Technology Center 2100

Decided: January 8, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and JAY P. LUCAS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 11-19, 21-23, 25-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60. We have jurisdiction under 35 U.S.C. § 6(b).

This application is a reissue of U.S. Patent No. 5,944,830 ("'830 patent"), issued on August 31, 1999, from Application No. 08/814,502, filed March 10, 1997. The invention relates to a power management apparatus for a video monitor. Proposed claim 11 is reproduced below.

11. An apparatus comprising:

a power supply providing power to a heater of a tube in a monitor; and

a switch being disposed between said power supply and the heater, said switch switching off the power provided to the heater when the monitor enters a power-off mode.

The examiner relies on the following reference:

Heineman 5,465,366 Nov. 7, 1995

The Examiner further relies on Appellants' "Admitted Prior Art."

Claims 11-19, 21-23, 25-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 stand rejected under 35 U.S.C. § 103 as being unpatentable over Appellants' "Admitted Prior Art" in view of Heineman.

In view of the Examiner's indications in the Final Rejection and the Answer, we conclude that claims 1-10 and proposed claims 49-54 are allowed. Proposed claims 20, 24, 34, 37, 39-41, 44, 45, 47, 48, and 57-59 are objected to, but would be allowable if rewritten in independent form.

OPINION

I. "Prior Art"

Judge Giles S. Rich observed that § 103 of Title 35 U.S.C., which makes nonobviousness of the invention a prerequisite to patentability, requires a determination of the differences between the subject matter sought to be patented and "the prior art." However, Title 35 nowhere defines the term "prior art."

> Its exact meaning is a somewhat complex question of law which has been the subject of legal papers and whole chapters of books. . . . Basically, the concept of prior art is that which is publicly known, or at least known to someone who has taken steps which do make it known to the public, . . . or known to the inventor against whose application it is being applied.

In re Bergy, 596 F.2d 952, 965 n.7 (CCPA 1979), *aff'd sub nom. Diamond v. Chakrabarty*, 447 U.S. 303 (1980) (citations omitted).

"The term 'prior art' as used in section 103 refers at least to the statutory material named in 35 U.S.C. § 102. . . . However, section 102 is not the only source of section 103 prior art. Valid prior art may be created by the admissions of the parties." *Riverwood Int'l Corp. v. R.A. Jones & Co.,* 324 F.3d 1346, 1354 (Fed. Cir. 2003) (citations omitted). However, while a reference can become prior art by admission, that doctrine is inapplicable when the subject matter at issue is the inventor's own work. *Id.*

Further, our reviewing court has held that subject matter derived from another (35 U.S.C. § 102(f)), when combined with other prior art, may make a resulting invention unpatentable under 35 U.S.C. §§ 102(f) and 103. *OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1403-04 (Fed. Cir. 1997).

II. Earlier Remand

In the § 103 rejection applied against all rejected claims, the Examiner relies on Figure 1 of the '830 patent, and the accompanying description at columns 1, 2, and 4 as "Admitted Prior Art." The '830 patent refers to the power management control apparatus of Figure 1 as an "earlier" apparatus in the "Description of the Related Art" section, and in the detailed description section at column 4. We remanded the proceeding to the Examiner (Sep. 1, 2004; Appeal No. 2004-1044) because the record was not clear with respect to whether the material considered by the Examiner as "Admitted Prior Art" could be used in a § 103 rejection.[1]

We suggested that the Examiner require the submission of information pursuant to 37 C.F.R. § 1.105, under the guidelines set forth in the *Manual of Patent Examining Procedure* (MPEP) § 704 (8th ed., Rev. 2, May 2004). MPEP § 704.11(b) notes that a requirement may be made at any time once the necessity for it is recognized and should be made at the earliest opportunity after the necessity is recognized. The MPEP also notes that, although optimally made prior to the first action on the merits, factors to be considered in a requirement include:

> (F) Whether the specification's background of the invention describes information as being known or conventional, which may be considered as an admission of

[1] As we noted in the Remand (at 3), Appellants' certified translation of the foreign priority document refers to the "conventional" power management apparatus of Figure 1.

> prior art, but such information is unfamiliar to [the] examiner and cannot be found within the application file or from the examiner's search, and further details of the information would be relevant to the question of patentability.

MPEP § 704.11(b) at 700-9.[2]

III. Appellants' Response to Requirement for Information

In a paper filed September 29, 2006, Appellants state (at 2):

> Applicant [sic] believes that the power management control apparatus illustrated in Figure 1 is simply an example of power management control apparatus that was well-known by people with ordinary skill in the art "at the time of Applicant's invention."

IV. Conclusion

We sustain the rejection of claims 11-19, 21-23, 25-33, 35, 36, 38, 42, 43, 46, 55, 56, and 60 under 35 U.S.C. § 103 as being unpatentable over Appellants' "Admitted Prior Art" in view of Heineman. All of Appellants' arguments in the Brief (filed Sep. 2, 2003) and the Reply Brief (filed Feb. 2, 2004) are based on the position that the "Admitted Prior Art" cannot be

[2] The current version of the MPEP (8th ed., Rev. 6, Sep. 2007) contains identical language.

applied against the instant claims.[3] We, therefore, find all the arguments to be unpersuasive of error in the Examiner's rejection.

We reject the notion that "prior art" as recited in 35 U.S.C. § 103(a) refers only to the material named in 35 U.S.C § 102. Appellants acknowledge that the subject matter at issue was well known by persons of ordinary skill in the art at the time of invention. Appellants do not show, or even allege, that the subject matter at issue is Appellants' own work (i.e., were the inventors of the power management control apparatus of Figure 1). It is axiomatic that, in determining the obviousness or nonobviousness of claimed subject matter, resolving the differences between the subject matter sought to be patented and "the prior art" requires consideration of the subject matter that was known to a person having ordinary skill in the art at the time of invention.

AFFIRMED

clj

[3] Appellants' representative at the oral hearing (Dec. 19, 2007) offered new arguments in support of patentability. The new arguments have not been considered, since they are untimely. *See* 37 C.F.R. § 41.47(e). We do not have the benefit of the Examiner's response to arguments that were not presented in the briefs.

ROBERT E. BUSHNELL AND LAW FIRM
1522 K STREET NW
SUITE 300
WASHINGTON, DC 20005-1202